

REMARKS/ARGUMENTS

Claims 1-51 are pending in the present application. Reconsideration of this application is respectfully requested in light of the following argument.

Information Disclosure Statement

The Office Action states that the information disclosure statement filed on December 26, 2000 fails to comply with 37 CFR 1.98(a)(2). Due to the volume of the references cited in the December 26, 2000 information disclosure statement, a new set of references will be submitted under separate cover. Therefore, the objection under 37 CFR 1.98(a)(2) is overcome.

Rejection under 35 USC § 102

The Office Action rejected Claims 1-15 and 31-51 under 35 USC § 102(e) as being anticipated by Birch et al. (U.S. Pat. No. 6,461,058), hereinafter called “Birch”. Without admitting that Birch is prior art and reserving the right to establish that Birch is not prior art, Applicants disagree with this reason of rejection. For instance, the present invention claims a housing having two connectors that is capable of coupling to two optical connectors at two different ends while Birch describes a housing having a single connector that is capable of coupling to one optical connector.

Claim 1 of the present application recites in part:

a housing having at least a first end and at least a second end, the first end of the housing capable of receiving the first optical connector, and the second end of the housing capable of receiving the second optical connector;

a longitudinal cavity extending from the first end of the housing to the second end of the housing;

(Emphasis added). The specification of the present application describes that:

The housing 124 comprises a mating end 1002, as shown in **FIG. 10a**, and a receiving end 1004, as shown in **FIG. 10b**. A longitudinal cavity 1006 extends through the housing 124 from the mating end 1002 to the receiving end 1004, as shown in **FIGS. 10a - 10b**.

See page 29, lines 5-10 of the present application. In light of the present invention, Claim 1 claims a first end of the housing is capable of coupling to a first optical connector and a second end of the housing is capable of coupling to a second optical connector. Claim 1 further claims a longitudinal cavity that extends from the first end to the second end of the housing. The first end of the housing may be coupled to an optical module while the second end of the housing may be coupled to an optical connector wherein the optical connector may be a MT type connector or MU type connector. See page 31 of the present application. An advantage of having a multiple-connector housing is to enhance the flexibility of optical alignment between an array of optoelectronic devices and an array of optical elements. See pages 31-32 of the application.

In contrast, Birch describes an optoelectronic component that contains an optical connector. See the abstract of Birch. Birch specifically states that a transceiver 1, shown in FIG. 1 of Birch, provides a connector part 2 to allow optical signals to be transmitted both in and out of the transceiver. See column 3, lines 3-5 of Birch. Birch, however, has never suggested or implied a second connector at another end of the component.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP §2131. Since Birch fails to disclose “a housing having at least a first end and at least a second end, the first end of the housing capable of receiving the first optical connector, and the second end of the housing capable of receiving the second optical connector” claimed in Claim 1 of the present invention, Birch cannot anticipate Claim 1. Furthermore, since Birch only discloses a

component have only one end with one connector, Birch cannot anticipate “a longitudinal cavity that extends from the first end to the second end of the housing” claimed in Claim 1 of the present invention. Accordingly, Applicants respectfully submit that Birch cannot anticipate Claim 1 of the present invention under §102. Since Claims 16 and 31 contain similar limitations as Claim 1, Claims 16 and 31 should also be patentable over Birch under §102. The Federal Circuit has ruled that if independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See *Jenric/Pentron, inc. v. Dillon Co.*, 205 F.3d 1377, 1382 (Fed. Cir. 2000). Since Claims 2-15, 17-30, and 32-45 depend from Claims 1, 16, and 31, respectively, Claims 2-15, 17-30, and 32-45 should also be patentable over Birch under §102.

Claim 46 recites in part:

(b) alignment ridges along the first and second surfaces of the mounting structure, the alignment ridges capable of securing a flexible printed circuit board that is wrapped around and attached to the first and second surfaces of the mounting structure;

Emphasis added. Birch cannot anticipate Claim 46 of the present application because it has never disclosed or mentioned the flexible printed circuit board. As mentioned earlier, to anticipate a claim, the reference must teach every element of the claim. MPEP §2131. Since Birch never discloses or suggests a flexible printed circuit board that can be wrapped around and attached to the mounting structure, Birch cannot anticipate Claim 46. Thus, Claim 46 is patentable over Birch under §102. Since Claims 47-51 depend from Claim 46, Claims 47-51 should also be patentable over Birch under §102.

Rejection under 35 USC § 103

The Office Action rejected Claims 16-30 under 35 USC § 103 as being unpatentable over Birch in view of Okugawa et al. (U.S. Pat. No. 5,163,109), hereinafter called

(“Okugawa”). Without admitting that Birch and Okugawa are prior art and reserving the right to establish that they are not prior art, Applicants disagree with this reason of rejection. The presently claimed invention cannot be obvious over Birch in view of Okugawa because neither Birch nor Okugawa discloses a housing that has two or more optical connectors.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In other words, each and every element (or limitation) in a claim must be taught somewhere in the applied references. If any one of the elements is not taught in any of the applied prior art, the obviousness rejection under §103 cannot stand.

The present invention discloses a housing that is capable of coupling to two optical connectors. Claim 16 of the present application recites in part:

a housing having at least a first end and at least a second end, the first end of the housing capable of receiving the first optical connector, and the second end of the housing capable of receiving the second optical connector;

a longitudinal cavity extending from the first end of the housing to the second end of the housing;

(Emphasis added). An advantage of having a multiple-connector housing is to enhance the flexibility for optical alignment between an array of optoelectronic devices and an array of optical elements. See pages 31-32 of the application.

In contrast, Birch, as discussed above, does not disclose a device having two or more ends wherein each end is capable of coupling to an optical connector and a longitudinal cavity that extends from the first end to the second end of the housing as claimed by Claim 16 of the present invention.

The Office Action correctly recognizes that Birch does not disclose every limitation listed in Claim 16. The Office Action, however, asserts that even though Birch does not

disclose every limitation claimed in Claim 16, the combination of Birch and Okugawa would make the present invention obvious to one skilled in the art. Applicants respectfully disagree with this assertion.

Okugawa discloses an optical connector assembly for connecting an optical fiber, an optical element, and an electric circuit together. See abstract of Okugawa. Like Birch, Okugawa does not disclose a component including two or more optical connectors. Applicants respectfully submit that a desired outcome that the invention provides cannot be used as the motivation to combine the references if there is no such teaching in the references. Since neither Birch nor Okugawa teaches or suggests a combination between Birch and Okugawa, Applicants contend that there is no teaching to combine.

Even assuming for the sake of argument that Birch and Okugawa were combined, the combination would still fail to render the present invention obvious because neither Birch nor Okugawa or a combination of both discloses or suggests a housing that a first end is capable of coupling to a first optical connector and a second end is capable of coupling to a second optical connector. Accordingly, one of ordinary skill in the art would not combine Birch and Okugawa, because even if they were combined, the combination would still fail to disclose or suggest all limitations disclosed in Claim 16. At least for this reason, Claim 16 is patentable over Birch in view of Okugawa under §103. Since claims 17-30 depend from Claim 16, Claims 17-30 should also be patentable over Birch in light of Okugawa under §103.

CONCLUSION

All pending claims in the present application are believed to be in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

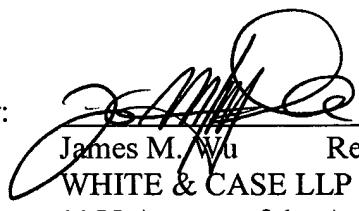
Appl. No. 09/749,285
Amdt. dated March 4, 2004
Reply to Office action of Sept. 4, 2003

If there are any charges believed due concerning this response, please charge to White & Case LLP Deposit Account 23-1703. Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (650)213-0300.

Respectfully submitted,

Dated: March 4, 2004

By:


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